

United States Patent and Trademark Office
Washington, D.C. 20231
1/12/2010

Dear Sir / Madam:

Please find attached a Petition for Review by the Director of Technology Center 2100 with respect to a Notice of Non-Compliant Appeal Brief for Application No. 09/287,478, with a mailing date of 11/12/2009.

Because the admissibility of certain Appeal Brief arguments depends in part on the success of this petition, a contemporaneous petition for an additional month of extension for the filing of an amended brief in response to said Notice of Non-Compliant Appeal Brief has been filed under 1.136(a) and (b), bringing the total extension to 2 months.

Thank you,

Handwritten signature of Chris Rode and the date 1/12/2010.

Chris Rode
Applicant PRO SE, 09/287,478
Rode Consulting, Inc.
6209 Stearns Hill Rd.
Waltham, MA 02451
781-899-4322

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	09 / 287,478	Confirmation No. 6350
Applicant	:	Christian S. Rode	
Filed	:	April 6, 1999	
Provisional Appl. Filed	:	60 / 080,905, 4/06/98	
TC./A.U.	:	2128	
Examiner	:	Thai Phan	
Docket No.	:	RCI001v1	

Director, Technology Center 2100

P.O. Box 1450

Alexandria VA 22313-1450

FAX: 571-273-8300

PETITION UNDER RULE 1.181

Dear Sir or Madam:

As regards a Notice of Non-Compliant Appeal Brief dated 11/12/2009, we respectfully wish to petition for review of the following issues:

1. Whether a post-final Information Disclosure Statement filing fee (1806, S1.17(p)) is, in fact, due for an IDS marked received October 19th, 2005, by the Central Fax Center before close of prosecution December 2, 2005 (mailing date of December 12, 2005).
2. Notwithstanding 1), an 1806/S1.17(p) fee has now been filed for said October 19th, 2005 IDS. Irrespective of whether item 1) of this petition proves successful, we request that the IDS now be accepted and entered

and prosecution of the application reopened as the fee has been paid and said IDS has significant bearing on the prior art cited by Examiner.

3. Whether examiner erred in interpreting MPEP 1205.02 such that when a section pursuant to 41.37(c)(1)(v)/(vi), is included by a *pro se* even though not required, and is found non-compliant, that such non-compliance is grounds for a rejection of the brief as a whole as Non-Compliant.

1. Statement of Fact

Subsequent to interview with Examiner on 21 September 2005, it was recommended by Examiner that Applicant document his deprecation of the functionality of Lawman, et al, as prior art via an Information Disclosure Statement. This was done via an IDS filed on 19 October 2005, and consisted of five (5) non-patent literature documents: 3 web pages from Xilinx's website, 1 page of email from Xilinx technical support and an archive copy of a page from a website designed by Applicant for a 3rd party and that featured Xilinx sponsorship. This IDS was filed as part of Applicant's continuing duty to disclose new information and was only found while writing Applicant's response to Examiner's citation of Lawman ('672), which was filed 9/22/2005, and such information was found within 3 months before the filing of said IDS.

Examiner issued his final rejection in December 2005, stating that the IDS had been received but not considered due to non-payment of fee specified by 37 CFR 1.17(p).

Applicant verbally questioned Examiner's request for this fee, but was unsuccessful in eliciting a response from the examiner beyond the fact that a fee was due.

Applicant, being *pro se* and unaware at the time of Rule 181 petitions, filed an appeal brief attempting to get the IDS admitted. When made aware of the requirement that only entered evidence may be appealed,

applicant attempted to attach the NPL documents contained in the IDS as evidence but has found this path apparently blocked as well.

A 37 CFR 1.97(e) affidavit was filed and received 2/19/2008 by OIPE (see “2008-02-19 Petition for review by the Office of Petitions” - actually containing a supporting letter, a record of a conversation with OPLA regarding the S1.17(p) fee and said affidavit), although Examiner has continued to request the S1.17(p) fee.

1. Argument

After consideration, Applicant believes Examiner's reticence to accept an affidavit only may be due to some apparent ambiguity in the wording of the 37 CFR 1.97(c):

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:
(1) The statement specified in paragraph (e) of this section; or
(2) The fee set forth in § 1.17(p).

Since this IDS was filed subsequent to an RCE, it is “post-final” in that sense, although prior to close of prosecution. However, some people in OPLA are of the opinion that only the affidavit was required at that time. An open question is whether the lack of the affidavit nullifies the filing date of the IDS, so regardless of whether a fee was due at the time, it is now due since the effective filing date is post-final. Another question then, is whether not only is a post-final IDS fee required but also a fee for a post-final submission.

As Material Assistance was requested in Applicant's response to Office Actions, we feel that Examiner has erred in not giving a more detailed explanation of his request for a fee, despite detailed

2. Statement of Fact

Notwithstanding the foregoing argument, Applicant recognized that payment of the S1.17(p) fee was a small cost compared to continuing to fight the issue and so fully intended to pay the fee with the amended brief filed 7/27/2009. Moneys were allocated to pay this fee.

In fact, however, to the best of Applicant's present knowledge this fee was apparently not paid, likely due to confusion on Applicant's part that the \$180 paid contemporaneously was payment of the S1.17(p), when, in fact, it was payment of the difference between a one month and two month extension $\$245 - \$65 = \$180$ (a 1 month extension had already been paid for on 6/26/2009), an unfortunate coincidence. The amended brief referred to payment of the fee as it was believed at the time that the fee had been paid.

As of 1/12/2010, this fee has been paid.

2. Argument

Regardless of payment or affidavit, it is plainly obvious from the content of the October 19th, 2005 IDS, and from Applicant's arguments that it was materially relevant to the validity of the Lawman as prior art. We suggest that examiner erred in closing prosecution without first giving Applicant an opportunity to correct the defect in the submission of said IDS.

As the fee has now been paid we request that the IDS of October 19th, 2005 be entered by examiner and either accepted for appeal arguments, or that prosecution be reopened.

3. Statement of Fact

In the notice of 5/26/09 box 5 is checked, referencing 37 CFR 41.37(c)(1)(vi). In the notice of 11/12/2009, box 4 is checked, referencing 37 CFR 41.37(c)(1)(v). In both cases the explanation under section 10 references Section E: Summary of

Claimed Subject Matter within the brief, pages 8 and 9, falling under 37 CFR 41.37(c)(1)(v).

Notice of 5/26/2009:

Continuation of 10. Other (including any explanation in support of the above items): On pages 8 and 9 of the appeal, appellant's informal comments are not related to the claims and the rejection of the claims before and during the prosecution. Such comments should not be included in the appeal to make the argument concise for each ground of rejection. The Brief should contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal.

Notice of 11/12/2009:

Continuation of 10. Other (including any explanation in support of the above items): On pages 8 and 9 of the appeal, appellant's informal comments are not related to the claims and the rejection of the claims before and during the prosecution. Such comments should not be included in the appeal to make the argument concise for each ground of rejection. The Brief should contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal.

I have checked MPEP section 1205.02 again, and the requirements do not appear to have changed: items 41.37(c)(1)(v) and 41.37(c)(1)(vi) need not be in compliance for a *pro se* appellant (page 1200-13):

*An exception to the requirement that all the items specified in 37 CFR *41.37(c)(1) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant pro se, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a pro se appellant which does not contain all of the items, **>(i) to (x)<, specified in 37 CFR *41.37(c)(1) will be accepted as long as it substantially complies with the requirements of items **>(i) through (iv) and (vii) through (x).<*

There would seem some ambiguity here as to when a *pro se* applicant chooses to include (v) and (vi), whether an error in formality in these sections may trigger a notice of brief non-compliance. As examiner has been silent on this issue, we ask that it be interpreted in the spirit in which it was apparently intended with regards to *pro ses*.

It should also be noted that the Notice of 5/26/2009 referred to the brief of 1/23/2008, not the version of 2/18/2008, the version I believe was reinstated by the Office of Petitions (see petition decision 6/23/2008), and that the latter version had a subsection to Section E, entitled "Informal Explanatory Comments", on pages 10 and 11. However, in both the amended briefs of 8/26/2009 and 9/19/2009 these pages were removed and so noted in the cover letter.

3. Argument

Therefore the examiner's objection is trebly confusing: 1) it objects to a section not required of a *pro se*, 2) which box was checked varies from 5/26/09 to 11/12/09 and 3) it is likely the pages it objects to have already been removed, or, that it meant to refer to the inclusion of dependent claims in the "Summary" section. Also, the phrase "Such comments should not be included in the appeal to make the argument concise..." is confusing as it seems to refer to the Arguments sections and not the Summary section. We ask that this objection be removed and if it was the cause for dismissal that the appeal be reinstated.

Conclusion

In Applicant's response to Examiner's Office Actions, applicant continually made appeals for Constructive Assistance under S2173.02 and S707.07(j). Applicant's interpretation of this would extend to a phone call before final rejection when a plainly relevant IDS is filed by a first-time *pro se* without required affidavit, or, during appeal, correcting Applicant's argument that, originally, no fee might have been due, but since prosecution closed before the affidavit was filed, now both affidavit and fee were due (if, in fact, this is found to be the case). A few additional sentences of explanation would likely have expedited prosecution.

If, in fact, Lawman is the best case that can be made for prior art with respect to interactive web CAD and the present application, we feel removal of Lawman necessarily leads to allowability of all claims. However, failing that we would hope that prosecution be reopened, and failing that we would hope that the appeal would be reinstated.

Very respectfully,

A handwritten signature in dark ink, appearing to read "Charles R. Smith". The signature is written in a cursive, somewhat stylized font. The first name "Charles" is written with a large, looped 'C'. The last name "Smith" is written with a large, looped 'S' and a distinct 'R' and 'M'.

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Amdt. Dated: Jan. 12, 2010
Petition under rule 1.181 regarding Notice of 11/12/2009

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Tel. 781-899-4322 Fax (same, but call first)

APPENDIX

Letter to SPE Kamini Shah and Examiner Thai Phan (Supplementary background / explanation)

Ms. Kamini Shah, SPE AU 2128
Supervisory Patent Examiner, AU 2128
FAX: 571-273-8300, 571-273-2279

Dear Ms. Shah,

I am the appellant, PRO-SE, for application 09/287,478, examined by Mr. Thai Phan.

Recently, I received another notice of defective appeal brief from the examiner, with consequent dismissal and abandonment, dated 11/12/2009. This was in response to an amended brief filed 9/19/2009 in response to a previous notice of defective brief from examiner filed 05/26/2009. I would like to ask for your review of the following objections made by the examiner.

1) In the notice of 5/26/09 box 5 is checked, referencing 37 CFR 41.37(c)(1)(vi). In the notice of 11/12/2009, box 4 is checked, referencing 37 CFR 41.37(c)(1)(v). In both cases the explanation under section 10 references Section E: Summary of Claimed Subject Matter within the brief, pages 8 and 9, falling under 37 CFR 41.37(c)(1)(v).

Notice of 5/26/2009:

Continuation of 10. Other (including any explanation in support of the above items): On pages 8 and 9 of the appeal, appellant's informal comments are not related to the claims and the rejection of the claims before and during the prosecution. Such comments should not be included in the appeal to make the argument concise for each ground of rejection. The Brief should contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal.

Notice of 11/12/2009:

Continuation of 10. Other (including any explanation in support of the above items): On pages 8 and 9 of the appeal, appellant's informal comments are not related to the claims and the rejection of the claims before and during the prosecution. Such comments should not be included in the appeal to make the argument concise for each ground of rejection. The Brief should contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal.

I have checked MPEP section 1205.02 again, and the requirements do not appear to have changed: items 41.37(c)(1)(v) and 41.37(c)(1)(vi) need not be in compliance for a pro se appellant (page 1200-13):

An exception to the requirement that all the items specified in 37 CFR 41.37(c)(1) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant *pro se*, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a *pro se* appellant which does not contain all

of the items, *(i) to (x)<, specified in 37 CFR *41.37(c)(1)< will be accepted as long as it substantially complies with the requirements of items *(i) through (iv) and (vii) through (x).<

It should be noted that the Notice of 5/26/2009 referred to the brief of 1/23/2008, not the version of 2/18/2008, the version I believe was reinstated by the Office of Petitions (see petition decision 6/23/2008), and that the latter version had a subsection to Section E, entitled "Informal Explanatory Comments", on pages 10 and 11. However, in both the amended briefs of 8/26/2009 and 9/19/2009 these pages were removed and so noted in the cover letter. We spoke briefly a few days after the notice was received here, and my understanding from you is that what is expected in this section a summary of the *independent* claims only, however this doesn't mesh with the examiner's objection since the Summary of Claimed Subject Matter extends from pages 4-9 and includes explanation of dependent claims throughout. A more plausible explanation is that the examiner kept this objection from the previous rejection.

Therefore the examiner's objection is trebly confusing: 1) it objects to a section not required of a pro-se, 2) which box was checked varies from 5/26/09 to 11/12/09 and 3) it is likely the pages it objects to have already been removed. Also, the phrase "Such comments should not be included in the appeal..." is confusing as it seems to refer to the Arguments sections and not the We ask that this objection be removed and if it was the cause for dismissal that the appeal be reinstated.

2) There has been an longstanding dispute over the admissability of an IDS originally filed 10/19/2005 and this is a central argument of the brief.

In part as followup to a telephone interview of 9/21/2005 and also as applicant's continuing duty to disclose relevant information applicant filed an IDS responsive to examiner's new citation of Lawman 6,324,672 in examiner's non-final rejection of 4/22/2009. The IDS of 10/19/2005 was filed in response to examiner's *new* citation of Lawman '672, and *well before* first final of RCE, (by almost 2 months) and so no fee should have been due. A responsive IDS could not have been filed before the RCE, since Lawman had not been cited to that point, as so no fee should have been due.

Per 609.04(b) II (r5):

An information disclosure statement will be considered by the examiner if filed after the period specified in subsection I. above, but prior to the date the prosecution of the application closes, i.e., before (not on the same day as the mailing date of any of the following:

- a final action under 37 CFR 1.113, e.g., final rejection;
- a notice of allowance under 37 CFR 1.311; or
- an action that closes prosecution in the application, e.g., an *Ex parte Quayle* action, whichever occurs first, provided the information disclosure statement is accompanied by either (1) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection III.B(5) below); or (2) the fee set forth in 37 CFR 1.17(p)...

After discussions with Mr. Kerry Fries of OPLA, it was determined that a missing affidavit was all that was required, however this was not apparent to me as pro-se in the early-2006 timeframe when this issue was under discussion and as pro-se I was unfamiliar with a section 181 petition to challenge it. An appropriate affidavit was filed and accepted as part of the petition to revive from unintentional abandonment (as accepted 6-23-2008). Recently, I have also paid the \$180 fee. Discussions with Mr. Phan had indicated that this IDS would be considered if the fee was paid but this has not happened to the best of my knowledge.

Additional note Jan. 7, 2007: Notice of Defective Appeal Brief of 7/16/2007 again specifically mentions the IDS of 10/19/2005 was not entered for lack of fee (see attached). A 37 CFR 1.97(e) statement from me was received by OIPE on 2/19/2008 (see attached). This evidence was also attached to the brief of 6/26/2009 with a declaration traversing objection or rejection (Appendix I2). Also, as noted in the 6/26/2009 amended brief, a fee of \$180 was included to doubly cover the issue of admission of the disputed IDS. (as noted on pg. 13 of brief of 6/26/2009, see attached).

Instead, there seems to be some unusual activity in the Transaction History after reinstatement (between 6-23-08 and 7-22-08) with regard to the IDS filed 11-18-2004, but that is not the relevant IDS. In fact, the 11-18-2004 IDS had already been entered by examiner in the December 2004 timeframe. If the 11-18-2004 IDS was mistakenly re-entered in place of a first entry for the 10-19-2005 IDS, this creates a problem with the appeal as unentered evidence cannot be referenced in an ordinary brief. However, I am appealing the non-entry of the information and so I must reference it.

Timeline relevant to Lawman ('672) and IDS of 10-19-2005.

12-14-2005	Third Final Rejection
10-19-2005	IDS #4
09-22-2005	Amendment F to application submitted
09-21-2005	Telephone interview (examiner summary 9-26-2005; applicant 10-19-2005)
04-12-2005	Non-final rejection
01-14-2005	IDS #3A-3D (Filed with RCE)
01-14-2005	RCE
10-22-2004 and 11/18/04	IDS #1 and #2 (These have been entered by examiner 12/27/2004)
07-15-2004	Second Final Rejection
12-15-2003	First Final Rejection

Regardless of the deficiency of affidavit or fee, the information was plainly relevant evidence with respect to citation of Lawman with respect to examiner's rejection of 4/22/2009, as explained verbally and in writing and so it should never have proceeded to final rejection without a resolution of this issue, particularly for a pro-se first application. Therefore, I have included the disputed IDS evidence, which if allowed intrinsically obviates examiner's objection to it ("On pages 12-13...Xilins' (sic) citation and Webmaster as well". Also, "On page 18, appellant argued Lawman patent does not work... On page 26... claims involved in the appeal.")

3) With respect to "In Ground 5, on page 12...", there is no longer any Ground 5 as noted in the cover sheet. There is only a Ground 2. This is further evidence that the examiner was referring to the older brief or perhaps just copying his arguments from the previous Notice of Non-Compliant Appeal Brief.

4) There is, however, an error correctly noted by the examiner, in the 3 time misused "Lawson (5,950,201)" where "Van Huben (5,950,201)" was meant ("On pages 15-17..."). This has been

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corrected in a newly amended brief but it is a new objection and therefore not grounds for dismissal, I believe.

Sincerely,
Christian S. Rode
Applicant, PRO-SE, 09/287,478
Waltham, MA 02451
781-899-4322

Supplemental Declaration regarding Petition

As an applicant in the above-identified application, I declare as follows:

1. If only one inventor is named below, I am a sole inventor, and if more than one inventor is named below, I am a joint inventor with the inventor(s) named below of the subject matter of the above identified application.
2. I have reviewed and understand the contents of the specification and claims, as originally filed, and as amended by the amendment(s) dated .
3. I believe that I, and the other inventor(s) named below if more than one inventor is named below, am the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
4. I acknowledge the duty to disclose information which is material to the examination of the application in accordance with 37 C.F.R. Section 1.56(a), and if this oath accompanies or refers to a continuation-in-part application, I acknowledge the duty to disclose material information as defined in 37 C.F.R. Section 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.
5. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Signature of Inventor



Printed Name of Inventor

Christian S. Rode

Date

1/12/2010